



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/664,773

09/17/2003

Lawrence Peter Conroy

4863

7590
Lawrence P. Conroy
Suite 201
2320 Central Street
Evanston, IL 60201

02/07/2007

EXAMINER

GRAYSAY, TAMARA L

ART UNIT

PAPER NUMBER

3636

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

02/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/664,773

Applicant(s)

CONROY, LAWRENCE PETER

Examiner

Tamara L. Graysay

Art Unit

3636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

However, the references have been considered by the examiner and are listed on the attached form PTO-892, Notice of References Cited.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5 and 6 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

- Claim 5, line 3: "the joists" lacks antecedent basis in the claim. The attempted positive recitation in the claim of the joist further renders the claim unclear as to

Art Unit: 3636

whether the claim is limited to the composite stud alone as mentioned in the preamble at line 1 or the composite stud in combination with a joist as mentioned at lines 3, 7, 11, 14.

- Claim 5, line 5: the composite stud being “of varying lengths” dependent on the location is confusing as to whether the claim is limited to a composite stud as mentioned in the preamble at line 1 or a plurality of composite studs having varying lengths.
- Claim 5, line 7: “the construction” lacks antecedent basis in the claim; and, the parenthetical note is indefinite as reciting an example of a construction and is confusing whether applicant intends the claim to be limited by the parenthetical note or not. The claim has been treated as not being limited by the parenthetical note.
- Claim 5, line 8: “the middle section” lacks antecedent basis in the claim and is unclear whether the middle section is a longitudinal, cross-sectional, or some other middle.
- Claim 5, line 9: “the vertical clearances” lacks antecedent basis in the claim.
- Claim 5, lines 9-10: “the building specifications” lacks antecedent basis in the claim and is confusing in that the preamble of the claim is limited to a composite stud.
- Claim 5, lines 10-13: the “except” clause is confusing as to whether the claim is directed to a composite stud adapted to connect between joists or a composite stud adapted to connect a joist and sloped rafter.
- Claim 5, line 11: “the ceiling joist” and “the roof rafters” lack antecedent basis in the claim.
- Claim 5, line 12: “the height” and “the angle of the roof rafters” lack antecedent basis in the claim.
- Claim 6 is not clear whether it is directed to a product or apparatus that includes the composite stud or to a process of “using” the composite stud. Claim 6 has been treated as a frame including at least the composite stud.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Wait (US-1911413).

Claim 5: Particular attention is directed to FIG. 8, which depicts a composite stud having an elongated H shape and an end interlock for receiving another building element (note lines 87-93 on the first page of the specification). Further, the composite stud includes a height that varies as depicted in FIGS. 2 and 8 dependent on the building element that is received in the groove defined by elements 20, 21, 22.

Claim 6: The stud may be used with frame construction, as broadly recited (note lines 87-93 on the first page of the specification).

4. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Lafrance (US-6209282).

Claim 5: The claim has been treated as being directed to the subcombination of a composite stud. Particular attention is directed to FIG. 3B which depicts a composite stud having an elongated H shape fastened to both sides of a joist. For example, joists 19 and 22 are fastened on both sides by the extended vertical portions 14, 14' of the composite stud. Looking further to FIG. 5A and 5B, the length of element 11 (comparable to applicant's element 10b) relative to elements 14 and 14' (comparable to applicant's elements 10a and 10c) is dependent on the orientation of the stud relative to the adjacent joists. For example, at the bottom, the length is sufficient to receive the

Art Unit: 3636

entire vertical dimension of joist 19 and at the top, sufficient to receive a portion of the vertical dimension of joist 22.

Claim 6: The stud may be used with frame construction, as broadly recited.

Response to Arguments

5. Applicant's arguments with respect to claims 5 and 6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3636


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Tuomi (US-4677806) teaches a composite stud having an angled surface for engaging a sloped roof 40. See FIG. 9 (elements designated with reference character 36,38), FIG. 13 (element 46). Tuomi further discloses the H shape having different lengths. See FIG. 15.
- Gilliland (US-4823519) teaches a varied length surface on a groove element (18a) for receiving an angled roof member (16a). See FIG. 6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is 571-272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn, can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Tamara L. Graysay
Examiner
Art Unit 3636

20070203